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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,382	08/06/2003	Donald Sheley Tracey	1999B062A	1278

23455 7590 08/04/2006

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/635,382	Applicant(s) TRACEY ET AL.	
	Examiner Geoffrey L. Knable	Art Unit 1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

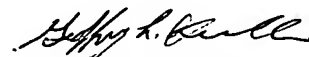
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 5, 6, 8-18, 20, 21 and 23-37.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


Geoffrey L. Knable
Primary Examiner
Art Unit: 1733

Continuation of 3. NOTE: Significant new issues are presented by the splitting up the Markush groups from claims 10, 14 and 32 and presenting deleted parts from these groups as new claims 38-40. .

Continuation of 5. Applicant's reply has overcome the following rejection(s): the 102(b) rejection of claim 18 over WO 01/48033 to Tracey et al., it being apparent that although the substance of this claim is not present in the patent (US 6,626,219) that issued from the parent applicaiton, upon further review, it was present in the original parent applicaiton (in much the same form as in the corresponding WO document).

Continuation of 11. does NOT place the application in condition for allowance because: First , with respect to claim 18, as noted above, it is agreed that this claim was entitled to the priority claim (the examiner inadvertently using the patent (6,626,219) that issued from the parent as representative of the disclosure of the parent and thus not noticing that although not present in this patent, it was present in the original parent application. With respect to claims 10, 14, 32 and new claims 38-40, these amendments raise new issues as noted above. It should be noted however that applicant's discussion of having priority to WO '033 "and is only required to swear behind WO ' 033 for what it teaches. See MPEP 715.02" is incorrect. First, technically it should be stressed that priority is to the parent application 09/736,524 and the prior provisional application, not WO '033. Secondly, if there is no descriptive support for any current claim in the parent application 09/736,524, then that claim is not entitled to priority and thus the filing date for such a claim would be the August 6, 2003 filing date for this application. In such case, WO '033 is available as prior art against that claim under 35 USC 102 (b) and therefore cannot be sworn behind - e.g. see MPEP 2133.01. As to claim 31, the disclosure of EPDM in the blends at the noted parts of WO '033 (page 2, lines 3-7 and compound 9 in the examples, WO '033 taken as equivalent to the parent priority application) is describing the prior art blends with butyl, not the inventive compositions as claimed. The arguments with respect to the other prior art rejection have also been carefully considered but are unpersuasive. In particular, applicant stresses that there is no reasonable expectation of success of using an innerliner composition for inner tubes, especially in view of paragraph [0028] as well as paragraph [0003] in the specification, it being urged that innerliner compositions would desirably stick to the tire such being undesirable for tubes. It should however be noted that paragraph [0028] is describing problems if the bromination levels exceed the noted range of 0.1 to 3.0 mol percent - levels consistent with this range are however suggested by Costemalle '662 (e.g. col. 9, lines 15-21) and thus following the teachings of this reference would not seem to necessarily raise the noted issues. Further, the discussion in paragraph [0003] is describing the problems with heat aging of typical butyl compounds - this however is precisely why the prior art suggest the inclusion of BIMS/EXXPRO - to provide expected improvement in heat aging, this therefore strongly motivating the artisan to use such, particularly as they are apparently aware of the heat aging problems present for inner tubes.